

REMARKS

Claims 1 and 8-13 are now present in this application.

Reconsideration of the application is respectfully requested.

Premature Final Rejection

Initially, Applicants respectfully submit that, because the outstanding Office Action fails to address a number of arguments presented by Applicants in the Amendment filed on July 28, 2005, as required by MPEP §707.07(f), and because the outstanding Office Action fails to address all features of the claimed invention, the finality of this Office Action is premature and should be withdrawn. Specific examples of these deficiencies are discussed, below in the detailed response to the Outstanding Office Action.

Traversal of Outstanding Rejections

Claims 1, 8 and 11-13 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 6,363,061 to Yuzawa in view of U.S. Patent 5,594,798 to Nakatsuyama. This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole, not just a few features of the claimed invention. Under 35 U.S.C. §103," [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the

invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d

1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972), and obviousness cannot be established by locating references which describe various aspects of appellant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what appellants have done. Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. App. & Int. 1993).

Firstly, Applicants respectfully submit that Yuzawa fails to disclose a number of positively recited claim features including (1) transmission and reception data size information

based on a communication speed, and (2) control data for notifying the received side of data . . . for representing information for requesting a compression ratio of the video data to be transmitted when the control index is controlled to select the quality of the image; and (3) control data for representing a sequence number for requesting the image retransmission when the retransmission of the image data is requested in the control index.

Yuzawa primarily discloses selecting proper data from a plurality of data multiplexed and downloaded by a receiver 6 from a digital communications satellite 5. According to its abstract, Yuzawa determines whether a program that is divided into a plurality of sections to be transmitted has been completely downloaded and ascertains the progress state of downloading the program.

Details for accomplishing this are set forth in columns 11 and 12 of Yuzawa, and are set forth, below.

“For example, in step S27 of Yuzawa’s Fig. 8, a section number Sno and a total section number Ssum are acquired. The section number Sno and the total section number Ssum are stored in, e.g., the RAM 23, and held until all the program data are completely downloaded. In the next step S28, it is checked whether a load section which is received at present is a section which has not been acquired. This determination is made on the basis of the section number Sno. Further, for example, each time a load section is received, the section number Sno acquired in step S27 is accumulatively stored in the RAM 23, and a table of the section numbers Sno of load sections which have been acquired is formed. Each time a new section number Sno is acquired, the table is referred to check whether a download process is performed.

If it is determined in step S28 that the section is not a section which has not been acquired, the flow returns to step S20 to receive the next load section.

On the other hand, if it is determined that the section is a section which has not been acquired, the flow shifts to step S29 to acquire program data from the code data region, and the main body of the program is downloaded. The downloaded program data is temporarily stored in a predetermined region of, e.g., the RAM 23.

The program data, as shown in FIG. 4, is stored in code data regions divided into N regions each having a size of 8 bits. The size of the program data stored in the load section can be recognized depending on the section length obtained in step S24 described above, and the value of N can be known. On the basis of the value of N, it is checked in step S30 whether the program data is downloaded by a predetermined size. If the download process for the predetermined size is not ended, the flow returns to step S29 to cause the download process to continue.

If it is determined in step S30 that the download process for the predetermined size is ended, the flow shifts to step S31. In step S31, it is checked whether a download process for a series of load sections in which the program data is stored is ended. This determination is made with reference to, e.g., the section number Sno accumulatively stored in the RAM 23. If it is determined that the download process is not ended, the flow returns to step S20 to perform a download process for the remaining sections.

If it is determined in step S31 that the download process for a series of load sections is ended, it is determined that the download process for the entire program data is completed. The series of processes are ended.

The download process for the entire program data is completed, the program data stored in the RAM 23 is transferred to the flash memory 22 by a predetermined method to be written in the flash memory 22. This process is performed on the basis of, e.g., a loader program stored in the ROM 21 in advance.

The progress state of downloading may be preferably displayed in the above download process. This progress state can be easily calculated by, e.g., execution of the process in step S29 in FIG. 8 on the basis of the total section number Ssum, the section number Sno accumulatively stored, the section length acquired in step S4, and the number of repeats of steps S29 and S30. Therefore, a percentage of downloaded program data to the entire program data at present can be displayed as in an example shown in FIG. 9. This display is performed by the following manner. That is, a display screen is formed by the image display generator 24 on the basis of the control of the unit controller 20, and the display screen is synthesized with an output from a video signal unit 12 by the adder 25.”

Unfortunately, the Office Action never explains what the aforementioned disclosure has to do with the aforementioned claim features.

The aforementioned argument was clearly set forth in the Amendment filed on July 28, 2005 but has not been addressed in the outstanding Office Action, contrary to the explicit requirement in MPEP §707.07(f) for the Examiner to respond on the merits to arguments presented by an Applicant. For this reason alone, the outstanding rejection is improper and should be withdrawn.

The outstanding Office Action also completely fails to address where Yuzawa discloses the positively recited feature of “transmission and reception data size information based on a communication speed.” This issue, i.e., where Yuzawa discloses this positively recited feature, was addressed by the Examiner in the previous Office Action dated March 28, 2005, and that treatment of this issue was addressed by Applicants in the Amendment filed on July 28, 2005, as follows:

For example, the Office Action states that, “ ‘transmission and reception data size based on communication speed is shown in Fig. 10, transmission and receiver system.” Applicants respectfully disagree because Fig. 10 is the prior art, described in cols. 1 and 2, and Fig. 10 fails to

disclose that the transmission and reception data size is based on communication speed. Nor do cols. 1 and 2 of Yuzawa, which include a detailed description of Fig. 10, contain such a disclosure. The only portions of Yuzawa that even mention the word “size” are found in col. 12, starting in line 14. Yuzawa’s disclosure about the size of code regions is, as follows:

“The program data, as shown in FIG. 4, is stored in code data regions divided into N regions each having a size of 8 bits. The size of the program data stored in the load section can be recognized depending on the section length obtained in step S24 described above, and the value of N can be known. On the basis of the value of N, it is checked in step S30 whether the program data is downloaded by a predetermined size. If the download process for the predetermined size is not ended, the flow returns to step S29 to cause the download process to continue.

If it is determined in step S30 that the download process for the predetermined size is ended, the flow shifts to step S31. In step S31, it is checked whether a download process for a series of load sections in which the program data is stored is ended. This determination is made with reference to, e.g., the section number Sno accumulatively stored in the RAM 23. If it is determined that the download process is not ended, the flow returns to step S20 to perform a download process for the remaining sections.

If it is determined in step S31 that the download process for a series of load sections is ended, it is determined that the download process for the entire program data is completed. The series of processes are ended.”

Yuzawa never discloses using transmission and reception data size information based on a communication speed. In fact, Yuzawa’s never discloses the basis for generating or utilizing its transmission and reception data size information or any use of such information.

Thus, the only evidence the Office Action presents to support the conclusion that Yuzawa discloses transmission and reception data size information based on a communication speed does not support the conclusion and Yuzawa's disclosure, quoted above, does not support the conclusion, either.

For some unstated reason, this entire issue has been dropped from the outstanding Office Action. Perhaps, in response to Applicant's arguments, above, the outstanding Office Action has withdrawn the argument that Yuzawa discloses this positively recited feature and does not even address this positively recited feature in the outstanding rejection. If so, this failure to address this issue in the outstanding Office Action is a tacit admission that claims 1-8 and 11-13 are patentable over Yuzawa.

Moreover, by failing to address this argument, the Office Action violates the express provisions of MPEP §707.07(f). For this additional reason, the rejection is incomplete, and improper, and should be withdrawn.

Furthermore, by not addressing this positively recited feature of the claimed invention, the Office Action does not make out a *prima facie* case that Yuzawa discloses the claimed invention. Applicants respectfully submit that this allegedly non-disclosed subject matter is not all that is not disclosed by Yuzawa, and that the Office Action fails to address exactly what is being claimed and fails to address the shortcomings of Yuzawa with respect to exactly what is being claimed.

What is actually recited, that is neither disclosed nor suggested by Yuzawa, is, as noted above, (1) transmission and reception data size information based on a communication speed, and (2) control data for notifying the received side of data . . . for representing information for requesting a compression ratio of the video data to be transmitted when the control index is

controlled to select the quality of the image; and (3) control data for representing a sequence number for requesting the image retransmission when the retransmission of the image data is requested in the control index.

Item (1) is treated above with respect to Yuzawa, where Applicants have shown above that Yuzawa does not disclose or suggest item (1).

Moreover, Yuzawa does not disclose or suggest varying the quality of the image, let alone requesting a compression ratio of the video data to be transmitted when the control index is controlled to select the quality of the index. In fact, the word “quality” only appears once in Yuzawa and only in the context of transmission quality for scrambled signals. See col. 1, lines 40-53 of Yuzawa.

Nor does Yuzawa disclose a protocol having control data for representing a sequence number for requesting the image retransmission when the retransmission of the image data is requested in the control index, as recited. In fact, Yuzawa does not even mention the term “sequence.”

Although these arguments were presented in the Amendment filed on July 28, 2005, they have not been addressed in this Office Action, contrary to the explicit requirement to do so in MPEP §707.07(f). For this reason alone, the outstanding rejection is improper, the finality of this Office Action is premature and should be withdrawn, and this Office Action itself should be withdrawn.

The outstanding Office Action also indicates that Yuzawa meets at least one of the features of the recited “a control index representing information for indicating an additional operation from the group consisting of an image quality selection, an image retransmission, a privacy mode and a

change in the size of video data and designation of conversion of image size data.” The Office Action states that one of these features is disclosed in Fig. 4, and col. 7, lines 48-54 of Yuzawa. Unfortunately, the Office Action does not state which one of the recited features is disclosed by the referenced portion of Yuzawa, but does refer to “code data ‘XN’ for change in the size of video.”

Applicants can find a disclosure of “code data” in Yuzawa, but can find no disclosure of “change in the size of video” at all in Yuzawa, let alone in col. 7, lines 48-54, which describes the header regions. Clarification is respectfully requested.

The Office Action then admits that Yuzawa fails to disclose “requesting a transmission ratio of the video data to be transmitted . . . to select the quality of the transmitted image.”

In order to remedy this admitted deficiency, the outstanding Office Action alleges that such a feature is well known in the art as evidenced by Nakatsuyama, with reference to Fig. 3 and cols. 1 to 2, lines 65-10.

Unfortunately, this rejection does not address what is claimed. What is claimed is a packet data transmission protocol having “a control index representing information for indicating an additional operation from the group consisting of . . . designation of conversion of image size data.”

Nakatsuyama clearly fails to disclose such a feature. In fact, Nakatsuyama refers to the user ID in the data designation information to control the modem to transmit compressed data from the variable compressor – see col. 7, lines 34-37. There is no hint of providing the claimed packet transmission protocol with the claimed control index in Nakatsuyama. Nor is such a protocol disclosed or suggested by Yuzawa, the base reference, which fails to disclose the claimed packet transmission protocol with the claimed control index.

Nor does the Office Action provide objective factual evidence that the existence of the allegedly well known feature “requesting a transmission ratio of the video data to be transmitted . . . to select the quality of the transmitted image” is objective factual evidence of one of ordinary skill in the art to modify Yuzawa to provide the recited protocol control index.

Moreover, Yuzawa does not disclose retransmission of image data requests, and the Office Action fails to demonstrate that it would be obvious to provide such a feature in Yuzawa, which is directed to satellite TV communications over multiple channels and contains data concerning specific receiver models, in view of Nakatsuyama, which is directed to a video on demand and audio on demand server-user system.

The only reasons the Office Action gives regarding motivation to modify Yuzawa in view of Nakatsuyama is “to avoid congested data communication network and flexibility for data transfer mode.”

Applicants also respectfully submit that this does not constitute objective factual evidence of proper motivation to modify Yuzawa, as suggested, for a number of reasons.

Firstly, Yuzawa does not disclose having a problem with transmission rates for different receivers, as does Nakatsuyama, so one of ordinary skill in the art would not look to Nakatsuyama to solve a problem that does not exist in Yuzawa. In other words, Yuzawa is designed for a “pay-per-view” situation (col. 1, lines 40-61) which uses a specific compressing/coding scheme for video and audio signals , e.g., MPEG-2 (col. 1, lines 21-23, and does not transmit variable compression rate data.

Secondly, Applicants respectfully submit that one of ordinary skill in the art would not go to the trouble and expense of modifying Yuzawa’s fixed compression coding/decoding scheme TV

pay-on-demand system that automatically determines whether a program should be downloaded based on specific receiver characteristics to achieve the claimed protocol features, which neither of these two references discloses or suggests, “to avoid congested data communication network and flexibility for data transfer mode,” as postulated in the rejection. Yuzawa has no congested data communication network that needs to be un-congested, and Yuzawa has no need for flexibility in its data transfer mode, other than to arrive at an invention that Applicants’ claims can read on. In view of this analysis, it is clear that the only basis for the proposed modification of Yuzawa in view of Nakatsuyama is improper hindsight reconstruction of Applicants’ claimed invention based solely on Applicants’ disclosure.

Furthermore, even if it were obvious to combine these two references, which is not the case for reasons stated above and because it has not been shown by objective factual evidence to be the case, the resulting modified version of Yuzawa would neither disclose nor suggest the claimed invention because, collectively, the applied references do not disclose all features that are positively recited in the claims.

Accordingly, the Office Action fails to make out a *prima facie* case of proper motivation to modify Yuzawa in view of Chou and, for that reason, and others set forth above, fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 1, 8 and 11-13 is respectfully requested.

Claims 9 and 10 stand rejected under 35 U.S.C. §103(a) as unpatentable over Yuzawa in view of Nakatsuyama and further in view of U.S. Patent 5,539,823 to Martin. This rejection is respectfully traversed.

This rejection is fundamentally improper because (1) the base reference combination of Yuzawa and Nakatsuyama is improper and does not render obvious the invention recited in claim 1, from which claims 9 and 12 depend, for reasons disclosed above, and (2) it fails to address all of the features of claim 1, which are found in claim 9, which depends from claim 1.

With respect to reason (1), above, because Martin is not applied to remedy the aforementioned deficiencies in the Yuzawa-Nakatsuyama reference combination, even if that reference combination were modified as suggested, it would neither disclose or suggest the invention recited in claims 9 and 10.

With respect to reason (2), above, this rejection only addresses the part of the claim preamble and the control index feature, failing to discuss, or treat in any manner, (1) the header data, (2) the transmission and reception data size, (3) the compressed audio and video data; and (4) the control data for notifying the receiver side of data relating to the additional operation, for representing information for requesting a compression ratio of the video data to be transmitted when the control index is controlled to select the quality of the transmitted image, and for representing a sequence number for requesting the image retransmission when the retransmission of the image data is requested in the control index.

For this reason alone, the rejection is fundamentally improper and should be withdrawn.

This last argument was presented in the Amendment filed on July 28, 2005 and not treated in the outstanding Office Action in violation of MPEP §707.07(f). For this reason alone, the outstanding rejection is improper, the finality of this Office Action is premature and should be withdrawn, and this Office Action, itself, should be withdrawn.

The Office Action also admits that Yuzawa does not disclose “inverse of video or audio data” but this is a known feature as shown by Martin in col. 1, lines 35+ for enhancement of viewing security.

Actually, this portion of the rejection fails to address exactly what is being claimed because it does not address the combination of features recited in claim 9, including “wherein the privacy mode is an information for representing an inverse of video and audio data and a reverse of video or audio data.”

The rejection only addresses the “inverse” and does not even address the positively recited “reverse of video or audio data.”

For this additional reason, the rejection is improper.

Accordingly, even if it were proper to combine these references, the resulting reference combination would still not disclose or suggest the aforementioned positively recited features that are neither disclosed nor suggested by these two references, or even addressed in the rejection itself.

Thus, this rejection is improper and should be withdrawn.

Reconsideration and withdrawal of this rejection of claims 9 and 10 are respectfully requested.

CONCLUSION

For the foregoing reasons, Applicants respectfully request the Examiner to reconsider and withdraw all of the rejections of record, and withdraw the finality of the Office Action, and earnestly solicit an early issuance of a Notice of Allowance.

Application No.: 09/764,064
Reply to October 19, 2005 Office Action

Docket No.: 0630-1221P

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster (Registration No. 46,472) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By Esther H. Chong
Esther H. Chong.
Registration No.: 40,953
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant